

EFW



S&H Form: (2/01)
Attorney Docket No. 1572.1147

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Ki-keon YEOM et al.

Application No.: 10/676,025

Group Art Unit: 3729

Confirmation No.: 6454

Filed: October 2, 2003

Examiner: KIM, Paul D.

For: DISC CENTERING DEVICE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Office Communication mailed March 15, 2006 setting a one-month shortened period for response set to expire on April 15, 2006, the Applicants respectfully submit the following remarks.

I. Provisional Election of Claims

Applicants provisionally elect to prosecute claims 1-16 (Group I) in response to the restriction requirement.

II. Applicants Traverse the Restriction Requirement Pursuant to 37 CFR § 1.143

The Applicants respectfully traverse the restriction requirement and request the Examiner also consider claims 17-18 (Group II) in addition to claims 1-16 (Group I).

The *Manual of Patent Examination Procedure (MPEP)* §803 provides two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and

(B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02).

Inventions Must be Independent or Distinct

Independent claims 1 and 17 are both directed to disc centering devices. They are identical except for the last two features of each claim, which read:

disc pushers which are slidably provided outside of the hub unit and include corresponding pressure members which push circumferences of the discs and center the discs; and
a driving unit which drives the disc pushers simultaneously. (cl. 1)

a disc centering unit having pushing members which are slidably provided outside of the hub unit and simultaneously pressurize circumferences of the discs to center the discs; and
a driving unit which drives the disc centering unit. (cl. 17)

The Examiner has taken the position that these two claims cover inventions that are distinct, each from the other because they are related as subcombinations disclosed as usable together in a single combination. *Office Communication*, page 2, paragraph 2. The Examiner asserts that claim 1 “has separate utility such as pressure members.” *Id.*

The Applicants respectfully submit that the reasoning offered by the Office Communication is inadequate to support a restriction requirement. *MPEP* §808.01 states:

The particular reasons relied on by the examiner for holding that the inventions as claimed are either independent or distinct should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

For example, relative to a combination and a sub-combination thereof, the examiner should point out the reasons why he or she considers the subcombination to have utility by itself or in other combinations, and why he or she considers that the combination as claimed does not require the particulars of the sub-combination as claimed.

The Examiner failed to provide reasons for holding that claims 17-18 (Group II) are directed to an invention that is independent or distinct from claims 1-16 (Group I). Rather, the Office Action merely alleges that claim 1 “has separate utility such as pressure members.” This is a mere statement of conclusion and is therefore inadequate.

Serious Burden on Examiner

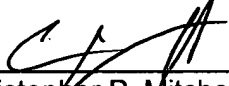
The Office Action has not set forth a serious burden on the Examiner to require restriction. Further, in view of the remarks herein, it is submitted that search and examination can be made without a serious burden. See *MPEP* 803.

The Applicants request reconsideration and withdrawal of the restriction requirement. In view of the remarks and when all of the other various facts discussed herein are taken into consideration, it is respectfully submitted that the criteria for a restriction requirement has not been met and all of the claims 1-18 should be examined together in the subject application. Withdrawal of the restriction requirement is respectfully requested.

Respectfully submitted,

STAAS & HALSEY LLP

Date: APR 11, 2006

By: 
Christopher P. Mitchell
Registration No. 54,946

1201 New York Ave, N.W., 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501